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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,275	03/13/2001	Daniel Bruce Anderson	ANDD100USA	1225
24339	7590	08/30/2005	EXAMINER	
JOEL D. SKINNER, JR. SKINNER AND ASSOCIATES 212 COMMERCIAL ST. HUDSON, WI 54016			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/805,275

Applicant(s)

ANDERSON ET AL.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Newly submitted claim 16 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: In the instant case the product as claimed can be made by another and materially different process such as by providing a protective case having an ingress/egress opening and an aperture disposed at an end and the aperture is adapted for extension therethrough of a strap disposed on an article such as a binocular etc. instead of a bow for the eyeglasses.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 16 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. However, claim 16 will be rejoined with claims 1-15 only if an eyeglasses are claimed in combination with claims 1 and 15.

**The previous Office Action mailed on 12/5/2003 has been withdrawn in favor of this Office Action.**

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4-7 and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. In claim 1, lines 4-5, the phrase "at and end thereof" is incomplete and indefinite.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-6 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiler (5,816,464; hereinafter Seiler'464). Seiler'464 discloses a protective case (10) for an article comprising a body portion defined an interior pouch (22) having an opening (44) centrally disposed in the body portion and an aperture (38) disposed at an end of the body portion (Figure 6). The opening of the body portion of Seiler'464 is inherently capable for insertion and removal of eyeglasses and the aperture is inherently capable of receiving a bow of the eyeglasses therethrough. As to claims 4-6, Seiler'464 discloses the device formed from a soft, flexible fabric or composite material such as rubber, neoprene, rubber bonded to fabric or the like. Since rubber is stretchable and is considered equivalent to a cloth-like material as claimed. As to claim 12, the top surface of the device as shown in Figure 6 is capable for displaying.

6. Claims 1, 4, 7 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassel (5,553,321). Cassel discloses a protective case (1) for an article comprising a body portion defined an interior pouch having an opening (16) centrally disposed in the body portion and an

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aperture disposed at an end (12) of the body portion (Figure 6). The opening of the body portion of Cassel is inherently capable for insertion and removal of eyeglasses and the aperture is inherently capable of receiving a bow of the eyeglasses therethrough. As to claim 4, Cassel discloses the device formed from a cloth-like material. As to claim 7, Cassel discloses the body portion comprises a lengthwise dimension with opposing end portions (12) and a widthwise dimension less than the lengthwise dimension. As to claim 12, the top surface of the device as shown in Figure 5 is capable for displaying.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiler (5,816,464; hereinafter Seiler'464) in view of Seiler (5,593,024; hereinafter Seiler'024).

Seiler'464 discloses the protective case (10) as above having all the limitations of the claims including means (46, 48) for closing the opening so the body portion is snugly around the article. However, Seiler'464 fails to show the means for drawing the body portion snugly around the article includes a single draw band being disposed about the opening. Seiler'024 shows a protective device (30) for eyeglasses comprising a body portion having an ingress/egress opening (32) and means for drawing the body portion snugly around the eyeglasses including a single draw band (37-39) disposed about the opening. It would have been obvious to one having

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ordinary skill in the art in view of Seiler'024 to modify the means for drawing of Seiler'464 so the means for drawing comprises a single draw band for better protecting the article disposed within the body portion.

9. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 9 above, and further in view of Baratelli (2,739,698). Seiler'464 further fails to show the means for drawing includes an elastic band. Baratelli teaches a protective case (5, 6) for eyeglasses including means for drawing a body portion of the case snugly around the eyeglasses and the means comprises an elastic band (18). It would have been obvious to one having ordinary skill in the art in view of Baratelli to modify the means for drawing of Seiler'464 as modified so the means for drawing comprises an elastic band to facilitate opening and/or closing the case and because the selection of the specific means for drawing such as hook and loop as disclosed by Seiler'464 or draw band as disclosed by Seiler'024 or elastic band as disclosed by Baratelli would have been an obvious matter of design choice of art recognized equivalent method inasmuch as a number of different ones appear to be suitable and inasmuch as applicant's specification does not state that using these specific features as claimed solves any particular problem or yields any unexpected results.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiler (5,816,464; hereinafter Seiler'464) or Cassel (5,553,321) in view of Conley (5,151,778). Seiler'464 or Cassel discloses the protective case as above having all the limitations of the claims except for the display portion includes an promotional material or an aesthetic design. Conley

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shows a protective case comprising a display portion (16) and the display portion having an indicia such as the term "FLOAT" (34) or the display portion permits a plurality of messages to be displayed on the case (Figure 6 and column 4, lines 13-16). It would have been obvious to one having ordinary skill in the art in view of Conley to modify the display portion of Seiler'464 or Cassel so the display portion includes an indicia such as an aesthetic design or promotional material for decorative or advertising purposes.

### ***Response to Arguments***

Applicant's arguments with respect to 6/10/2004 have been considered but are deemed to be moot in view of the new grounds of rejection.

The Declaration under 37 C.F.R. 1.132 filed on 6/10/2004 has been reviewed and persuasive.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Errica Miller at (571) 272-4370.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (571) 273-8300 for Formal papers and After Final communications.



Luan K. Bui  
Primary Examiner

lkb  
August 22, 2005